



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,174	07/08/2003	Keiichi Takashima	00862.023125.	6463

5514 7590 05/31/2006

FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER

BLACKWELL, JAMES H

ART UNIT PAPER NUMBER

2176

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/614,174	<b>Applicant(s)</b> TAKASHIMA, KEIICHI	
	<b>Examiner</b> James H. Blackwell	<b>Art Unit</b> 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 March 2006.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. This Office Action is in response to an amendment filed 03/13/2006 with a priority date of **07/09/2002**.
2. Claims 1-9 are pending in this application. Claims 1-3 are independent claims.
3. Claim 10 was cancelled by the Applicant without prejudice or disclaimer of the subject matter presented.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carew et al. (hereinafter Carew, U.S. Patent Application Publication No. 2003/016292 filed 03/07/2002, published 09/11/2003).

In regard to independent Claims 1 (and similarly Claims 2, and 3), Carew teaches a dynamically filled web list. Carew starts with a typical HTML form containing form elements and in particular a dynamic listbox element (Pg. 3, Paragraph [0032]). Carew then introduces a modification by creating a special tag <DynamicList> that contains an HREF element and URI (collectively a URL) that points to a network accessible database containing the contents of the list (Pg. 3, Paragraph [0033]). Though Carew fails to explicitly teach a traditional form processing mechanism (i.e. cgi scripting), Carew, inasmuch as a web browser can be broadly interpreted as a *form-processing device* (e.g., displays form, allows for interaction with, executes dynamic content contained therein), and the dynamic listbox a *field data file*, the browser processes the form as per the usual way until the user selects the drop-down listbox. The web browser recognizes the <DynamicList> tag within the SELECT tag (compare this with the limitation of *first determination means for determining whether a field*

Art Unit: 2176

*associated with the information stored in the field data file is defined as a field onto which an external file is to be overlaid*), then detects the HREF, URI combination (a URL), then fetches the content from the web server to overlay onto the listbox for the user who then is able to select from the list (Pg. 4, Paragraph [0039]). This series of steps is comparable to the claimed limitation of *overlaying means for downloading the external file from a network server based in the URL data and overlaying the downloaded external file onto the field when the second determination means determines that the information stored in the field data file is the URL data*). Thus, Carew teaches a form processing mechanism that scans a file containing form element data looking for those form elements containing references to external files which contain data pertinent to that form element, and replacing fields with the content contained in the external file. This method of processing forms would have been obvious to one of ordinary skill in the art at the time of invention and would have provided the advantage of up-to-date information for the user to select.

**In regard to dependent Claim 4**, Claim 4 reflects the form processing device as claimed in Claim 1 (and similarly Claims 2, and 3), and is rejected along the same rationale. In addition, Carew teaches a storage step in the sense that the content of the external file is stored in the listbox form element. Carew fails to teach storing the external file on a local disk. However, as was typical at the time of invention, it was well known that web pages downloaded to clients from servers were cached on local (client) devices (e.g., memory, disks).

Art Unit: 2176

**In regard to dependent Claims 5-9, Carew fails to teach these limitations.**

However, these limitations depict common and typical operations and procedures relating to caches, and in particular, caching web content on a client as a normal operation of browsers in existence at the time of invention, rendering such limitations as claimed, obvious, providing the benefit of speedy display and functionality of web pages.

***Response to Arguments***

6. Applicant's arguments, see amendment, filed 03/13/2006, with respect to the rejection(s) of claim(s) 1-9 under Brown have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Carew, which teaches locating form field elements and reference mechanisms relating to external file content, and in particular URLs, and retrieving that content for overlay into that form element providing the benefit of up-to-date and current form selection options.

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Blackwell whose telephone number is 571-272-4089. The examiner can normally be reached on Mon-Fri.

8. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2176

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James H. Blackwell  
05/26/2006

*William S. Bashore*  
**WILLIAM BASHORE**  
**PRIMARY EXAMINER**  
*5/28/2006*